UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/469,007	12/21/1999	MARK H. LINEHAN	RSW9-99-080	4403

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EXAMINER
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ART UNIT	PAPER NUMBER
2611	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 November 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,7,8,20,26,27,39,45,46 and 58-61* is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,7,8,20,26,27,39,45,46 and 58-61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

  a)☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

Response to Amendment

1.   This action is responsive to a request for continued examination filed 11/26/03. Claims 1,

7-8, 20, 26-27, 39, 45-46 and 58-61 are pending. Claims 1, 7-8, 20, 26-27, 39, 45-46 and 59 are

amended. Claims 60-61 are new.

Response to Arguments

2.   Applicant's arguments filed with respect to claim 1, 7-8, 20, 26-27, 39, 45-46 and 58-59

have been fully considered but they are not persuasive. Applicant argues that the claimed

invention differs from the prior art in that the merchant is not responsible for the referral

processing because the merchant is not necessarily trusted. Applicant further states that the TV

context information is sent from a consumer, through a merchant, to a bank where the payment

processor resides. The Examiner points out that Applicant is arguing limitations of the prior art

in view of the application's specification and not the claims. When read in the broadest possible

context, Applicant's claimed subject matter does not disclose the location of the payment

processor except in dependant Claim 58. Further, the Daly patent discloses a payment processor,

which is independent of the merchant (See Figure 1) that makes use of digital signing such that

the processor is independent of, and trusted by both the purchaser and the merchant (Col. 4,

Lines 5-12). The system of Daly clearly illustrates that the merchant is not necessarily trusted as

the merchant is prevented from gaining access to the purchaser and payment information (Col. 3,

Lines 52-53). Daly also discloses that the purchasing system is in communication with the

appropriate sponsoring institution (bank) as is well known in the art (Col. 13, Lines 22-34). It

would have therefore been obvious to one having ordinary skill in the art that the functions of the

purchasing computer could have been encompassed by the banking computer since the merging

of functions from separate, connected computers into a single computer is well-known in the art.

Finally, the Examiner points Applicant to the previously disclosed Franklin patent which teaches

an online commerce system using a digital signature and hiding sensitive information from an

un-trusted merchant wherein the electronic commerce system is implemented in a bank

computer.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   Claims 1, 7-8, 20, 26-27, 39, 45-46 and 58-61 are rejected under 35 U.S.C. 103(a) as

being unpatentable over U.S. Patent No. 5,878,141 to Daly et al. in view of U.S. Patent No

6,029,141 to Bezos et al.

Regarding Claims 1, 20 and 39, Daly discloses a system, method and computer

program product for enabling television-based (Col. 6, Lines 39-44) commerce for

generating revenue streams. It is inherent that the system would generate revenue for the

TV originators, such as the television provider, for providing the service to the users for

the merchants. The product is a software program (Col. 7, Lines 40-42) that is readable

by a computer system (Col. 6, Lines 37-55) in an interactive television environment (Col.

9, Lines 8-10) connected to a computer network (Col. 6, Lines 56-59). This reads on a computer readable media readable by one or more computer systems. Daly further discloses computer-readable program code means for a consumer initiating a purchase via the TV commerce system (Col. 7, Lines 1-47) using the interactive television environment (See Figure 5) wherein the transaction pertains to an offering of a merchant (102). Daly also discloses the use of a digital signature (Col. 8, Lines 47-61) for securely transmitting context information (Col. 7, Lines 1-5) that corresponds to the consumer's payment to the merchant for the transaction. The payment processor is a trusted third party that is independent of both the merchant and the purchaser (Col. 7, Lines 40-46) that processes payments for the merchant. Because communication between the purchasing server and the client are encrypted and digitally signed (Col. 14, Lines 10-19), it is inherent that the context information reaches the payment processor in an unaltered form. It is further inherent that digital communications, such as in the system of Daly, use packetized data to communicate between systems. This reads on the claimed series of payment protocol messages. What is not disclosed, however, is a means for gathering TV context information related to the transaction, including the context information in the payment protocol message and automatically allocating by the payment processor, a portion of the consumer's payment to one or more TV originators according to the securely-transmitted TV context information and reducing the amount of the payment to the merchant by the automatically allocated portion. Bezos discloses computer-readable networked-based commerce software where additional context information is gathered and included in a payment message corresponding to a transaction (Col. 7, Lines 20-45).

Further, Bezos discloses including the gathered context information in a payment

protocol message (Col. 12, Lines 57-65) corresponding to the transaction. Bezos

discloses sending the payment protocol message to a payment processor that processes

payments for the merchant (See Figures 1 and 2) to initiate the consumer's payment to

the merchant (See Figure 9). The payment processor must inherently receive the payment

protocol message in order to complete the transaction. Bezos also discloses automatically

allocating a portion of the payment to the originator through the use of the included

context information (Col. 13, Lines 1-4). It is inherent that the payment to the merchant

would be reduced by the amount allocated to the purchase originator. Bezos is evidence

that ordinary workers in the art would recognize the benefit of collecting and transmitting

context information for billing and commission purposes in an electronic commerce

system. Therefore, it would have been obvious to one having ordinary skill in the art at

the time the invention was made to combine the computer program product for enabling

TV-based commerce of Daly with the embedded context information of Bezos in order to

track, record, and process data regarding the nature and origin of an online purchase.

Regarding Claims 7, 26 and 45, Daly in view of Bezos discloses a system as

stated above in Claims 1, 20 and 39. Bezos further discloses a system wherein the

program uses the included context information for extracting the identification of the

content originators (Col. 12, Lines 52-63) and determining a portion to be allocated using

a predetermined percentage (Col. 13, Lines 1-4) of the payment for each of the content

originators for whom the identification is extracted.

Regarding Claims 8, 27 and 46, Daly in view of Bezos discloses a system as stated above in Claims 1, 20 and 39. Bezos further discloses a system wherein the included context information is sent to the content originators (Col. 16, Lines 11-19 and Appendix B) from the payment processor. It is inherent that this data must be extracted from the securely transmitted TV context information. Additionally, the content originator receiving the vendor's funds will receive among other things, the name and account information of the purchaser, which are elements of the context information. It is inherent in such a system that this information will be sent to the content originators in the form of a statement or payment notification.

Regarding Claim 58, Daly in view of Bezos disclose a method as stated above in Claim 39. Daly discloses that the payment processor is independent of the merchant as stated above. Daly further discloses that the payment processor checks with a sponsoring financial institution to determine if a purchaser is within their credit limit (Col. 13, Lines 22-35). In the system of Daly, the payment processor is in communication with an acquiring bank. It is inherent that the server running the payment processor software could be located anywhere with a network connection, including at a bank or other locations in communication with a bank.

Regarding Claim 59, Daly in view of Bezos disclose a method as stated above in Claim 46. It is inherent in such a system that the merchant receives the included context information from the payment processor in order to process the purchase for shipping and record keeping.

Regarding Claim 60, Daly in view of Bezos disclose a method as stated above in

Claim 39 wherein the securely transmitting step comprises the step of digitally signing

the gathered TV context information as stated above.

Regarding Claim 61, Daly in view of Bezos disclose a method as stated above in

Claim 60. It is inherent that in a system using digital signatures the receiving end checks

to determine that the data it receives is in an unaltered form by verifying the digital

signature. This reads on the claimed payment processor determining that the gathered TV

context data information is unaltered.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155.

The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the

organization where this application or proceeding is assigned is (703 308-5359.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 306-0377.

mrd

December 17, 2003

ANDREW FAILE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Paper No. 9

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on <u>10/29/03</u> is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see *68 Fed. Reg. 38611*, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following item(s) is required. **Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted.** 37 CFR 1.121(h).

THE FOLLOWING CHECKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

☐   1. Amendments to the specification:
     ☐   A. Amended paragraph(s) do not include markings.
     ☐   B. New paragraph(s) should not be underlined.
     ☐   C. Other_____

☐   2. Abstract:
     ☐   A. Not presented on a separate sheet. 37 CFR 1.72.
     ☐   B. Other_____

☐   3. Amendments to the drawings: _____

☐   4. Amendments to the claims:
     ☐   A. A complete listing of <u>all</u> of the claims is not present.
     ☐   B. The listing of claims does not include the text of all claims (including withdrawn claims)
     ☐   C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
     ☐   D. The claims of this amendment paper have not been presented in ascending numerical order.
     ☐   E. Other: <u>The complete listing of claims should include status identifiers and text. If claims are canceled test is to be omitted (example: Claims 2-6 (Canceled).</u>

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf .

If the non-compliant amendment is a **PRELIMINARY AMENDMENT**, applicant is given ONE MONTH from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and **this ONE MONTH time limit is not extendable.**

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION (including a submission for an RCE)**, and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a TIME PERIOD of ONE MONTH from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION**, this form may be an attachment to an Advisory Action. **The period for response to a final rejection continues to run from the date set in the final rejection**, and is not affected by the non-compliant status of the amendment.

_____   (703) 306-2941
Legal Instruments Examiner (LIE)   Telephone No.

Rev. 10/03